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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/802,468      | 03/09/2001  | Kenneth J. Ruchala   | 013869-9001         | 5869             |

23409 7590 08/25/2005

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EXAMINER

AHMED, SAMIR ANWAR

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2623

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/802,468

**Applicant(s)**

RUCHALA ET AL.

**Examiner**

Samir A. Ahmed

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-191 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-191 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The amendment filed 3/21/05 have been entered and made of record.
2. Applicant has amended independent claims 2, 14, 19, 126, 148, 170 to traverse the prior art of record. Applicant's arguments filed 3/21/05 have been fully considered but they are moot in view of new grounds of rejection.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-14 and 17-191 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,915,005 to Ruchala et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in Patent No. 6,915,005 and is covered by the patent, as follows: the claims of the patent specify the details of augmenting tomographic projection image of a patient, which is broadly required by the claims of the instant application. Because the claims of both the instant invention and the patent use the transitional term "comprising" which fails to preclude the existence of additional

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features, and because the common disclosure supports the use of these features together, the claims of both the patent and the instant application cover an embodiment that includes all of the details of both sets of claims. Therefore, the claims of the instant application cover subject matter that overlaps the claims of the patent.

Claims 1-2, 14, 19, 104, 126, 148, 170 of the instant application recite similar limitations recited in claims 1, 22, 30, 32, and 33 of Patent 6,915,005.

Claim 3 of the instant application recites similar limitations recited in claim 23 of Patent 6,915,005.

Claim 4 of the instant application recites similar limitations recited in claim 24 of Patent 6,915,005.

Claim 5 of the instant application recites similar limitations recited in claim 25 of Patent 6,915,005.

Claim 6 of the instant application recites similar limitations recited in claim 26 of Patent 6,915,005.

Claims 7, 23, 44, 65, 86, 108, 130, 152, 174 of the instant application recite similar limitations recited in claim 27 of Patent 6,915,005.

Claim 8 of the instant application recites similar limitations recited in claim 28 of Patent 6,915,005.

Claim 9 of the instant application recites similar limitations recited in claim 29 of Patent 6,915,005.

Claim 10 of the instant application recites similar limitations recited in claim 7 of Patent 6,915,005.

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Claims 11, 21, 42, 63, 84, 106, 128, 150, 172 of the instant application recite similar limitations recited in claim 8 of Patent 6,915,005.

Claims 12, 17 of the instant application recite similar limitations recited in claim 3 of Patent 6,915,005.

Claim 13 of the instant application recites similar limitations recited in claim 13 of Patent 6,915,005.

Claims 22, 43, 64, 85, 107, 129, 151, 173 of the instant application recite similar limitations recited in claim 9 of Patent 6,915,005.

Claims 24, 45, 66, 87, 109, 131, 153, 175 of the instant application recite similar limitations recited in claim 10 of Patent 6,915,005.

Claims 26, 47, 68, 189, 111, 133, 155, 177 of the instant application recite similar limitations recited in claim 11 of Patent 6,915,005.

Claims 32, 53, 74, 95, 117, 139, 161, 183 of the instant application recite similar limitations recited in claim 12 of Patent 6,915,005.

Claims 33, 54, 75, 96, 118, 140, 162, 184 of the instant application recite similar limitations recited in claim 14 of Patent 6,915,005.

Claims 34, 55, 76, 97, 119, 141, 163, 185 of the instant application recite similar limitations recited in claim 15 of Patent 6,915,005.

Claims 35, 56, 77, 98, 120, 142, 164, 186 of the instant application recite similar limitations recited in claim 16 of Patent 6,915,005.

Claims 36, 57, 78, 99, 121, 143, 165, 187 of the instant application recite similar limitations recited in claim 17 of Patent 6,915,005.

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Claims 37, 58, 79, 100, 122, 144, 166, 188 of the instant application recite similar limitations recited in claim 18 of Patent 6,915,005.

Claims 38, 59, 80, 101, 123, 145, 167, 189 of the instant application recite similar limitations recited in claim 19 of Patent 6,915,005.

Claims 39, 60, 81, 102, 124, 146, 168, 190 of the instant application recite similar limitations recited in claim 20 of Patent 6,915,005.

Claims 40, 61, 82, 103, 125, 147, 169, 191 of the instant application recite similar limitations recited in claim 21 of Patent 6,915,005.

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

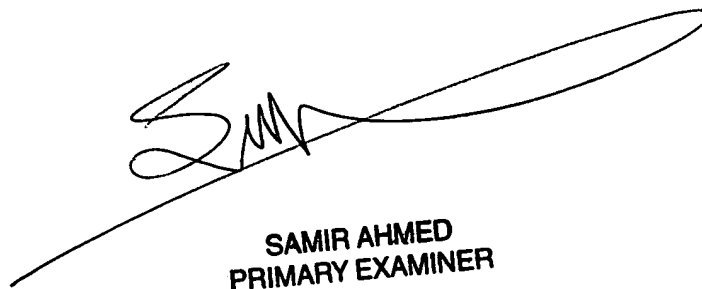
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samir A. Ahmed whose telephone number is (571) 272-7413. The examiner can normally be reached on Mon-Fri 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (571) 272-7414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SA



**SAMIR AHMED  
PRIMARY EXAMINER**